

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:	10/055,773	§	Examiner:	Hamza, Faruk
Filed:	January 22, 2002	§	Group/Art Unit:	2155
Inventors:		§	Atty. Dkt. No:	5681-06800
	Bernard A. Traversat, et al.	§		
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Title:	Peer-to-Peer Computing	§		
	Architecture	§		
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. Review is requested for the reasons stated below.

Claims 1-116 are pending in the application. Reconsideration of the present case is earnestly requested in light of the following remarks. Please note that for brevity, only the primary arguments directed to the independent claims are presented, and that additional arguments, e.g., directed to the subject matter of the dependent claims, will be presented if and when the case proceeds to Appeal.

The Examiner rejected claims 1-3, 8-13, 15, 17-22, 25-30, 32-38, 40, 42, 44, 45, 47-60, 62, 63, 65-80, 82-84, 86, 87, 89, 90, 92-101, 103, 104, 106-108 and 110-116 as being anticipated by Weisman et al. (U.S. Publication 2002/0112058) (hereinafter "Weisman"). Applicants respectfully traverse this rejection for at least the reasons below.

The rejection is improper because Weisman is not a prior art reference. The Weisman publication was filed on June 1, 2001, after Applicants' priority date of April 24, 2001. The December, 1, 2000 filing date of Weisman's provisional application can only be used as Weisman's 35 U.S.C. § 102(e) prior art date for the subject matter that is common to both the Weisman publication and the provisional

application. A review of Weisman's provisional application reveals that it varies considerably from Weisman's published utility application. For instance, **Weisman's provisional application does not appear to disclose or mention, anything regarding using the UPnP API for peer-to-peer networking purposes**, as relied on by the Examiner in the rejection of Applicants' claims. Unless the Examiner can prove that the subject matter on which the Examiner is relying on to reject Applicants' claims is also entirely present in Weisman's provisional application, the rejection is improper. *See*, M.P.E.P. § 2136.03(III); *In re Wertheim*, 209 USPQ 554 (CCPA 1981). Applicants assert that much of the subject matter on which the Examiner is relying on to reject Applicants' claims is not present in Weisman's provisional application. Therefore, the filing date of Weisman's provisional application cannot be used as the prior art date for Weisman's published application.

Moreover, the Weisman publication is not entitled to the December, 1, 2000 date as a section 102(e) prior art date unless at least one claim of the Weisman published application is supported (under 35 U.S.C. § 112) in the provisional application (*See*, e.g., 35 U.S.C. 119(e)(1)). **Weisman's provisional application does not contain full § 112 support the claims of Weisman's utility application.** For example, Weisman's provisional application does not appear to support peer networking protocol limitations of claim 1 in Weisman's utility application. The rejection is improper unless the Examiner can show that Weisman's published application has the necessary claim support in Weisman's provisional application to be entitled to the provisional application's filing date as its § 102(e) prior art date. *See also* M.P.E.P. § 2136.03(IV). Since the Examiner has not provided the necessary evidence to show that the Weisman publication is prior art to the present application, the current rejection is improper.

In the Advisory Action (response B) the Examiner asserts that Weisman's provisional does support Weisman's utility application and further states, "It is respectfully requested that the burden is on the applicant to prove otherwise." **However, the burden to establish a proper rejection falls on the Examiner, not the applicants. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), cert. denied, 389 U.S. 1057 (1968).** Moreover, Applicants have already provided examples of deficiencies of Weisman's provisional. As discussed above, Weisman's provisional does not support using UPnP API for peer-to-peer networking, and also does support the peer networking protocol limitations of claim 1 of Weisman's utility application. The Examiner has never substantively responded to these arguments or cited any portion of Weisman's provisional that provide support for the subject matter on which the Examiner relies.

Furthermore, regarding claim 1, even if Weisman did qualify as prior art, Weisman fails to disclose wherein at least one of the one or more peer-to-peer platform protocols is configured to be

used by a peer node to discover peer nodes that are members of specified peer groups. Instead, Weisman teaches a discover protocol that allows hosted devices to broadcast a service advertisement that describes a service provided by the hosted device (paragraphs [0045], [0839-0844], and [0849]). Weisman's device hosting framework provides hosting for software-implemented logical devices on a computer to expose their services as controlled devices per a peer networking protocol. Please see Applicants' previous response filed July 2, 2007 for a more detailed discussion of Weisman's failure to disclose all the limitations of claim 1.

In response to the above arguments, the Examiner, in the Advisory Action, cites paragraphs [0813-0819] and [0838-0847] of Weisman that describes UPnP networking. The Examiner does not provide any argument or explanation regarding how this passage can be interpreted to support the Examiner's argument. Nothing in the cited passage mentions any *peer-to-peer platform protocols configured to be used by a peer node to discover peer nodes that are members of specified peer groups.* Weisman, at the Examiner's cited passages, describes two methods for one device to discover another in Weisman's system. In contrast to the Examiner's contention, Weisman states, "a control point may learn of a device of interest because that device sent discovery messages advertising itself or because the device responded to a discovery message searching for devices. Thus, not only is Weisman silent regarding peer-to-peer platform protocols configured to be used by a peer node to discover peer nodes that are members of specified peer groups, Weisman teaches other means for a device to discover other devices that does not involve such a peer-to-peer platform protocol, as recited in Applicants' claim. The rejection of claim 1 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 36, 59, 77 and 101.

Regarding claim 53, the Examiner has failed to even attempt to provide a proper *prima facie* rejection. The Examiner merely asserts that claim 53 does "not define or teach any new limitations other than [the] above claims 1-3, 6, 8-13, 15, 17-22, 25-30, and 32-35. The Examiner is improperly ignoring both the specific language and the particular limitations of claim 53 that are not recited in any of claims 1-3, 6, 8-13, 15, 17-22, 25-30, and 32-35.

In further regard to claim 53, Weisman fails to disclose *wherein the peer node is configured to move from the network location to a different network location; wherein the program instructions are further executable within the peer node to discover and access a different instance of the service on a different one of the plurality of peer nodes.* Please see Applicants' previous response dated July 2, 2007, for a more detailed discussion of Weisman's failure to disclose all the limitations of claim 53. In the response to arguments of the Final Office Action, the Examiner argues that "Applicants' argument is

inconsistent with claims.” However, the difference between the wording of Applicants’ arguments and the claims was non-substantive and inconsequential. Moreover, Applicants revised the wording of the arguments in the last response to match the claim language. The Examiner’s response is without merit, and **the Examiner has not substantively responded to any of Applicants’ arguments**. Please see Applicants’ response filed July 2, 2007, pages 8-9 for a more detailed response to the Examiner’s comments. Similar remarks also apply to claims 73, 97 and 116.

The Examiner has also failed to provide a proper *prima facie* rejection of, nor does Weisman disclose all the recited limitations of, claims 55, 56, 57, 58, 73, 75, 76, 97, 99, 100, 114, 115 and 116. Please see Applicants’ previous response filed July 2, 2007, pages 9-14 for a more detailed discussing regarding Weisman’s failure to teach all the recited limitations of these claims and rebutting the Examiner’s arguments and responses.

The Examiner rejected claims 1-116 under the judiciary created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Pat. No.: 7,065,579. Applicants traverse this rejection on the grounds that the Examiner has clearly not met the requirements stated in MPEP 804.II.B.1 to establish a *prima facie* obviousness-type double patenting rejection. The Examiner has provided a table that the Examiner claims shows the similarity of the claimed inventions of application number 10/055,773 and U.S. Pat. No. 7,065,579. (Specifically, of claim 1 of the instant application and claim 1 of U.S. Pat. No. 7,065,579). **As can easily be seen from the Examiner’s own table, there are many differences between the claims. The Examiner has not provided reasons or evidence showing that *all* of the differences would be obvious, as is required to state a *prima facie* double patenting rejection per MPEP 804.II.B.1.**

In the Advisory Action, the Examiner argues (response A), “It is respectfully requested that the applicant explain his position ‘many differences between the claims.’” As applicants have argued repeatedly, **the Examiner has not specifically addressed each difference of each rejected claim** of the present application compared to the claims of the other applications. Instead, the Examiner improperly lumped all the claims together without addressing each specific difference. Additionally, the Examiner rejects dependent claims 2-35, 37-52, 60-72, 74, 78-96, 98 and 102-112 because “they depend from rejected claims.” This is not a valid basis for rejection. The Examiner does not attempt to list any differences between these claims and the claims of the ‘579 patent. Nor does the Examiner attempt to give reasons why one of ordinary skill would conclude that these claims are obvious variations of the claims of the ‘579 patent. **The burden to establish a proper rejection falls on the Examiner, not the**

applicants. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S. 1057 (1968).
Applicants respectfully request removal of the double patenting rejection of claims 1-116.

In light of the foregoing remarks, Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5681-06800/RCK.

Also submitted herewith is a Notice of Appeal.

Respectfully submitted,

/Robert C. Kowert/

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